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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,617	02/09/2004	Sou Phong Lee	51529/JDC/A23	8682

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EXAMINER

SASTRI, SATYA B

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/774,617

Applicant(s)

LEE, SOU PHONG

Examiner

Satya B. Sastri

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6-16, 19-23, 26-31, 34, 37, 40-48 is/are rejected.
- 7) ☒ Claim(s) 2, 5, 17, 18, 24, 25, 32, 33, 35, 36, 38 and 39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to amendment filed on August 16, 2006. *Claims 1-48* are now pending in the application.

2. In view of the applicant's arguments, all previous rejections are withdrawn. New rejections are presented in this office action.

Claim Rejections - 35 USC § 102 and 103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. *Claims 1, 3, 4, 6-16, 19-22* are rejected under 35 U.S.C. 102(b) as anticipated by Feret et al. (US 5,798,406).

Prior art to Feret et al. concerns fluorinated (meth)acrylic lattices and hydrophobic coatings resulting therefrom. The latex particles include a perfluorinated (meth)acrylates (abstract) with 2,2,2, trifluoroethyl(meth)acrylate as the preferred species (column 1, lines 29-41).

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In one embodiment, the monomer composition of the fluorinated particles or of the shell of the fluorinated structured particles may include (a) 20-80% of at least one perfluorinated (meth)acrylate, (b) 20-80% by wt. of a monomer capable of yielding a homopolymer with low Tg (i.e. a soft monomer), (c) 0-30% by wt. of a monomer capable of yielding a homopolymer with high Tg (i.e. a hard monomer), (d) 0-10% by wt. of at least one carboxylic monomer, (e) 0-3% of a crosslinking monomer and (f) 0-5% of a hydrophilic monomer. As monomer (b), butyl acrylate and 2-ethylhexyl acrylate are explicitly disclosed. Monomers (c) include methyl methacrylate and styrene. Monomer (d) is preferably (meth)acrylic acid. The crosslinking monomer (e) may be a hydrophilic or hydrophobic crosslinking agent. With regard to monomer (f), ethylimidazolidone (meth)acrylate and acrylamide are disclosed (column 4). The fluorinated shell polymerization may be carried out in the presence of a chain transfer agent (column 6, lines 27-37). As for the emulsifying agents, a combination of anionic and nonionic surfactants with 10-40 ethylene oxide units is disclosed (column 6, lines 57-67, column 7, lines 1-4). Thus, the instant claims are anticipated by the prior art.

With regard to the preamble, the intended use language must result in a structural difference to patentably distinguish over the prior art. If the prior art structure or composition is capable of performing the intended use, then it meets the claim. MPEP 2112.02. The preamble of the instant claims merely show the environment in which the copolymer operates and thus the instant compositions that comprise the copolymer are fully anticipated by the prior art. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

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6. **Claims 23, 26-31, 34, 37, 40-46** are rejected under 35 U.S.C. 103(a) as being unpatentable over Feret et al. (US 5,798,406).

Prior art to Feret et al. is presented above in paragraph 5 and is incorporated herein by reference.

The difference between the prior art and the instant invention is that the prior art does not teach the use of various monomer and useful ranges as recited in instant claims.

The prior art teaches the specific hard and soft comonomers as recited in instant claims. Given that the prior art teaches the functional equivalence of the various hard and soft comonomers, it would have been obvious to a skilled artisan to use any of the functionally equivalent hard or soft monomers, including a combination of monomers to obtain a copolymer. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the any of the functionally equivalent monomers, including a combination of the same and thereby obtain the instant invention, absent evidence of unexpected results.

7. **Claims 47, 48** are rejected under 35 U.S.C. 103(a) as being unpatentable over Feret et al. (US 5,798,406) in view of Heimberg (US 4,409,355).

Prior art to Feret et al. is presented above in paragraph 5 and is incorporated herein by reference.

The difference between the prior art and the instant invention is that the prior art does not disclose acrylic copolymer composition coated on or laminated to a facestock material.

The prior art discloses the acrylic copolymer composition as a coating composition. However, such acrylic copolymers containing compositions may also be used as pressure

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sensitive adhesive composition by incorporating appropriate additives. For instance, Heimberg discloses high solids containing copolymer acrylic latices for formulation as paints and other surface coatings and as low pressure sensitive adhesives (column 3, lines 14-17). Given that the acrylic copolymer may be used in a variety of applications, it would have been obvious to one of ordinary skill in the art at the time the invention to coat facestock materials with the coating compositions of Feret et al. and thereby obtain the instant invention.

Allowable Subject Matter

8. ***Claims 2, 5, 17, 18, 24, 25, 32, 33, 35, 36, 38, 39*** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Instant claims disclose copolymer compositions comprising an aliphatic urethane di(meth)acrylate. Such modifications are not disclosed in the prior art of record.

Conclusion

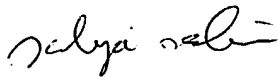
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satya Sastri at (571) 272 1112.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached at (571) 272 1114.

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The fax phone number for the organization where this application or proceeding is assigned is (571) 273 8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SATYA SASTRI

October 25, 2006



DAVID W. WU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700